

REMARKS

Applicants respectfully request reconsideration of the present application. No new matter has been added to the present application. Claims 1-6, 8-18, 20-30, and 32-36 were rejected in the Office Action. No claims have been amended, added, or canceled herein. Accordingly, claims 1-6, 8-18, 20-30, and 32-36 are pending herein. Claims 1-6, 8-18, 20-30, and 32-36 are believed to be in condition for allowance upon review and acceptance of these remarks. Favorable action is respectfully requested.

Rejections based on 35 U.S.C. § 103(a)

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections Based on Yang and Barth

Claims 1-4, 8-16, 20-28, and 32-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the U.S. Patent Application Publication No. 2002/0169889 by Yang et al. (“Yang”) in view of U.S. Patent Application Publication No. 2006/0123012 by Barth et al. (“Barth”). As the combination of Yang and Barth is improper and the references, either alone or in combination, fail to teach or suggest all limitations of the claims, Applicants respectfully traverse this rejection, as hereinafter set forth.

Independent claim 1 recites a system for monitoring a networked computer service for fault recovery. The networked computer service includes a set of features. When a fault condition for one or more features is detected in network status data, the system automatically generates control commands to dynamically adjust the set of features based on the fault condition. The set of features are dynamically adjusted by deactivating the one or more features having a fault condition while maintaining active features in the set of features to continue to provide the networked computer service. In other words, when a feature included in

a set of features for a service experiences a fault condition, the feature is deactivated such that the remaining features may continue to operate without degradation from the deactivated feature such that the service may be provided to an end user.

In contrast to the invention of claim 1, Yang is directed to a zero-loss web service system. The system “ensures that the service of any user-submitted request suffers zero loss even in the case of a server failure or overload.” *Yang*, ¶ [0020] (emphasis added). To provide zero loss, when a server failure arises, processing continues on another server. *Id.*, ¶ [0025].

Accordingly, Yang is directed to a system that may maintain a service without any loss of the service. This is in direct contrast with the invention of claim 1 in which a failed feature of a service is intentionally deactivated to allow the other features to continue to operate without degradation. By definition, the invention of claim 1 is not a zero-loss system as discussed in Yang. Instead, in claim 1, when a fault condition is detected for a feature of the service, the feature is deactivated such that the feature is removed from the service. As such, Yang fails to teach or suggest multiple features of claim 1. For instance, Yang fails to teach or suggest an “output interface, communicating with the control engine and the computer services network, the output interface communicating the control commands to the computer services network to dynamically adjust the set of features by deactivating the one or more features having a fault condition while maintaining active features in the set of features to continue to provide the networked computer service.”

The Office Action has acknowledged that Yang fails to teach or suggest all limitations of the invention of claim 1 (*see Office Action*, p. 3-5), but has minimized the extent of the differences between Yang and claim 1. As set forth by the United States Supreme Court in *Graham v. John Deere*, 383 U.S. 1 (1966), inquiries as a background for determining

obviousness include, *inter alia*, determining the scope and contents of the prior art, and ascertaining the differences between the prior art and the claims at issue. *See, e.g.*, MPEP § 2141. In the present case, the Office Action has not adequately ascertained the differences between Yang and the invention of claim 1. As indicated above, the approach in Yang does not involve dynamically adjusting a set of features by deactivating a feature having a fault condition such that the active features may be maintained. Rather, Yang teaches a different approach that includes a zero-loss web service to maintain a service without any loss. Thus, there are significant differences between Yang and claim 1, and the invention of claim 1 advances the state of the art beyond what is taught in Yang.

Barth was cited by the Office Action in an attempt to demonstrate that the differences between the invention of claim 1 and Yang were merely obvious differences. However, Applicants respectfully submit that the combination of references is improper. Initially, Applicants note that Yang teaches away from the invention of claim 1. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” MPEP § 2141.02. “A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness.” MPEP § 2145. As noted above, Yang is specifically directed to a zero-loss web service. *See, e.g., Yang*, Abstract, ¶ [0020]. Yang teaches a system in which there is no loss of service by allowing processing to continue on another server where a server failure occurs. *See, e.g., id.*, Abstract, ¶¶ [0020], [0025]. The system “ensures that the service of any user-submitted request suffers zero loss even in the case of a server failure or overload.” *Id.*, ¶ [0020] (emphasis added). A system that intentionally prevents any loss of

service, such as in Yang, clearly teaches away from a system in which a feature is intentionally deactivated, as in the invention of claim 1. The disclosure of a zero-loss system in Yang is inconsistent with claim 1 and would have led one skilled in the art away from the invention of claim 1. As such, there is no suggestion or motivation to modify Yang to achieve the invention of claim 1.

Additionally, there is no suggestion or motivation to modify Yang to achieve the invention of claim 1 because such modification would render the invention in Yang unsatisfactory for its intended purpose. “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” MPEP § 2143.01. One intended purpose of the system in Yang is to provide a zero-loss service. *See, e.g., Yang*, Abstract, ¶ [0020]. For instance, Yang states that it “ensures that the service of any user-submitted request suffers zero loss even in the case of a server failure or overload.” *Id.*, ¶ [0020] (emphasis added). To achieve the invention of claim 1, the system in Yang would have to be modified such that it would intentionally deactivate a feature having a fault condition. However, this modification would cause the system in Yang to no longer provide a zero-loss service. Accordingly, Applicants respectfully submit that the modification would render the system in Yang unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to modify Yang to achieve the invention of claim 1.

Similarly, Applicants respectfully submit that there is no suggestion or motivation to modify Yang to achieve the invention of claim 1 because the modification would change the principle of operation of the system in Yang. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified,

then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP § 2143.01. The principle of operation of the system in Yang includes preventing any loss of service by allowing processing to continue on another server where a server failure occurs. *See, e.g., Yang*, Abstract, ¶¶ [0020], [0025]. To modify Yang in an attempt to achieve the invention of claim 1 would destroy the principle of operation of Yang because instead of preventing any loss of service by using another server, a feature would have to be intentionally deactivated. Accordingly, Applicants respectfully submit that the modification would change the principle of operation of the system in Yang, and thus there is no suggestion or motivation to modify Yang to achieve the invention of claim 1.

Furthermore, Applicants respectfully submit that even if Barth were combined with Yang, the resulting combination would still fail to teach or suggest all limitations of independent claim 1. In particular, Barth also fails to teach or suggest dynamically adjusting a set of features by deactivating a feature having a fault condition to maintain active features to continue to provide a service. In contrast to the invention of claim 1, Barth merely discusses a dynamic information connection engine for searching information. *See, e.g., Barth*, Abstract. The portion of the reference cited by the Office Action discusses searching travel information and using a timer to determine when search results are considered valid. *See, e.g., id.*, ¶¶ [0112], [0113]. After the time period expires such that search results are considered no longer valid, the search results are deactivated. *Id.* Deactivating search results when search results are no longer considered valid based on a timer as in Barth is different from deactivating features having a fault condition to maintain other active features as recited in claim 1. Accordingly, Barth fails to

cure the deficiencies of Yang as the combination of references would still fail to teach or suggest all features of claim 1.

As such, it is respectfully submitted that Yang and Barth, either alone or in combination, fail to teach or suggest all limitations of claim 1, and the combination is improper. Therefore, claim 1 is patentable over Yang and Barth. Independent claims 13 and 25 include features similar to those discussed above with respect to claim 1, and, as such, claims 13 and 25 are patentable over Yang and Barth. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 13, and 25 under 35 U.S.C. § 103(a). Claims 1, 13, and 25 are believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 2-4, 8-12, 14-16, 20-24, 26-28, and 32-36 depend directly or indirectly from independent claims 1, 13, and 25. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of these claims as well.

C. Rejections Based on Yang, Barth, and DeBettencourt

Claims 5, 6, 17, 18, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang and Barth in view of U.S. Patent Application Publication No. 2002/0042823 to DeBettencourt et al. (DeBettencourt). Applicants respectfully traverse the rejection of claims 5, 6, 17, 18, 29, and 30 as hereinafter set forth.

Claims 5, 6, 17, 18, 29, and 30 depend from independent claims 1, 13, and 25, and, as such, are patentable over Yang and Barth for at least the reasons cited above. DeBettencourt fails to cure the deficiencies of Yang and Barth with respect to their failure to teach or suggest multiple limitations of the base claims, 1, 13, and 25 and the improper combination. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claims 5, 6, 17, 18, 29 and 30.

CONCLUSION

For at least the reasons stated above, claims 1-6, 8-18, 20-30, and 32-36 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or jgolian@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/John S. Golian/

John S. Golian
Reg. No. 54,702

JSG/drb

SHOOK, HARDY & BACON L.L.P.

2555 Grand Blvd.

Kansas City, MO 64108-2613

816-474-6550